

Att'y Docket No.: P40281

Customer No.: 07055

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Peter BECHER et al.

Appln. No. : 09/744,149

U.S. Patent No. 6,764,569

Filed : July 3, 1999

Issued: July 20, 2004

For : ADHESIVE SYSTEM FOR FORM REVERSIBLE GLUED JOINTS

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SEP 06 2011REQUEST FOR CONSIDERATION OF PETITION TO ACCEPT DELAYED
PAYMENT OF MAINTENANCE FEE UNDER 37 C.F.R. 1.378(b)

Commissioner for Patents
U.S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

Certificate of Transmission

I hereby certify that this correspondence is being facsimile trans-
mitted to the United States Patent and Trademark Office. Fax No
(571) 273-8300 on 09-06-11 (Date)

Typed or printed name of person signing this certificate:

Teddy Adman

Signature: Teddy Adman

Sir:

Pursuant to the July 5, 2011 dismissal of Petitioner's Petition under 37 C.F.R. 1.378(b) to Accept Delayed Payment of the Maintenance Fee Under 37 C.F.R. 1.378(b) due on the above-identified patent, Petitioner respectfully requests reconsideration of the Petitions Examiner's decision. As this request for reconsideration is being presented within two months of the July 5, 2011 decision date, i.e., by September 6, 2011 (September 5, 2011 being a U.S. Federal holiday), Petitioner requests consideration of the previous decision and granting of the Petition, whereby the patent will not be considered as having been expired.

The above-identified patent was issued on July 20, 2004. The first maintenance fee could have been paid with the surcharge set forth in 37 C.F.R. 1.362(e)(1) as late as July 20, 2008. Since the maintenance fee was not paid, the patent expired after midnight on July 20, 2008.

A petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in Section 1.20 (e) through (g);
- (2) the surcharge set forth in Section 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the

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patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

COMPLIANCE WITH REQUIREMENTS UNDER 37 C.F.R. 1.378(b)

(1) MAINTENANCE FEE

The required first maintenance fee of \$980.00 as set forth in Section 1.20(e) is enclosed herewith.

(2) SURCHARGE

The required surcharge of \$700.00 as set forth in Section 1.20(i)(1) is enclosed herewith.

(3) SHOWING OF UNAVOIDABLE DELAY

As corroborated in the attached updated Statements by Ms. Stefanie LINDNER and Mr. Dirk OSTERMANN, both employees in the Patent Department of the assignee Fraunhofer-Gesellschaft zur Forderung der angewandten Forschung e.V. [hereinafter "Fraunhofer"], the delay in paying the first maintenance fee was unavoidable and this grantable petition was promptly prepared and submitted after the patentee was notified of the expiration of the patent.

The undersigned states that the delay in payment of the maintenance fee was unavoidable. This statement is based on information provided to the undersigned as outlined below:

U.S. Application Number 09/744,149, which matured into U.S. Patent No. 6,764,569, was assigned by the inventors to co-assignees DaimlerChrysler AG [hereinafter "Daimler"], Fraunhofer, and Henkel KgaA [hereinafter "Henkel"]. The assignment was recorded on March 29m 2002 at Reel 012823 and Frame 0191

Per agreement of the co-assignees, while the application was pending in the U.S. Patent and Trademark Office, Daimler was responsible for communicating with and providing instructions to U.S. counsel, Crowell & Moring LLC, on behalf of co-assignees Fraunhofer and Henkel.

After the patent's issuance, per the co-assignee's agreement, Daimler remained

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responsible for the monitoring and payment of U.S. maintenance fees on behalf of co-assignees Fraunhofer and Henkel.

According to the U.S. Patent and Trademark Office's PAIR system, on October 1, 2004, Dennemeyer & Co. Luxembourg was assigned as the address for fee purposes.

Per agreements dated May 17, 2005 and June 13, 2005, Fraunhofer purchased the shares of Daimler and Henkel in the invention throughout the world, which included in U.S. Patent No. 6,764,569 and its European counterparts.

While neither the agreements nor any other documents evidencing Fraunhofer's sole ownership of the patents were recorded in the U.S. Patent and Trademark Office's Assignment Branch, through these agreements, Fraunhofer became the sole owner of U.S. Patent No. 6,764,569 and also became responsible for paying the maintenance fees on the patent.

Fraunhofer uses a patent administration software product known as PatOrg as their internal docketing system to, *inter alia*, docket for and monitor annuity/maintenance fees. In the course of the normal business routine, Fraunhofer personnel enter patent numbers and maintenance fee due dates into the system and contact a party, such as an annuity service, to instruct payment the fees, which is confirmed by entering the party's name into the system as payer. Fraunhofer's PatOrg software product has been set up to provide a routine check of the entries in the system, and to generate a list of matters that have payment due dates entered but do not identify a party instructed to pay the fees.

Ms. Stefanie LINDNER has been employed by Fraunhofer in the department of patents and trademarks since 2001. In the course of her employment, Ms. LINDNER regularly attends internal and external training events, and she has been trained to use the PatOrg software product. Accordingly, in the course of her normal business routine, Ms. LINDNER enters patent numbers and maintenance fee due dates into the system, contacts parties, such as an annuity service, to arrangement payment of maintenance fee, and enters into the system the name of the party instructed to pay the fees as payer.

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After the agreements giving Fraunhofer sole ownership of U.S. Patent No. 6,764,569 and, thereby responsibility to pay the maintenance fee, were completed, Ms. LINDNER reviewed an attachment to the agreement listing the family member patents involved in the assignment in order to instruct an annuity service to maintain the patents. The annuity due dates for maintaining the European counterpart patents were forwarded to the annuity service PAVIS with instructions to pay the fees. However, through a mistake, Ms. LINDNER did not inform PAVIS of the U.S. Patent or provide PAVIS with instructions to pay the U.S. maintenance fee.

As is part of her normal business routine, Ms. LINDNER entered the U.S. patent number and the maintenance fee due date into the PatOrg system. However, while Ms. LINDNER instructed PAVIS to pay European annuities, she failed to inform PAVIS to pay the first U.S. maintenance fee. Further, Ms. LINDNER also erroneously entered into the system that PAVIS had been instructed to pay the fees for maintaining the U.S. Patent. As a result of these errors, Fraunhofer personnel were unaware that Fraunhofer was still responsible for payment of the first maintenance fee. Moreover, because PAVIS had been mistakenly entered into the system as having been instructed to pay the maintenance fee, the routine check by the software did not identify this patent as a matter requiring designation of a payer.

The maintenance fee was not paid by Fraunhofer and the patent expired after midnight on July 20, 2008. Fraunhofer was not informed of the expiration of U.S. Patent No. 6,764,569.

On February 16, 2011, Mr. Dirk OSTERMANN of Fraunhofer, conducting a routine check of the Fraunhofer database, discovered that the patent identified PAVIS as the responsible party for paying the maintenance fee. Mr. OSTERMANN then searched the U.S. Patent and Trademark Office's PAIR system and discovered that the patent had expired for failure to pay the first maintenance fee.

On February 17, 2011, Mr. OSTERMANN contacted the undersigned law firm of Greenblum & Bernstein, P.L.C. to inquire whether late payment of the maintenance fee would be accepted by the U.S. Patent and Trademark Office

The undersigned replied to Mr. OSTERMANN's letter on February 17, 2011 noting that, as the patent had been expired for more than 24 months, that a Petition for Acceptance of Delay

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Maintenance Fee in Expired Patent would be required under the unavoidable standard of 37 C.F.R. 1.378(b). Greenblum & Bernstein provided details of the petition and presented the requirements for making the showing that the delay was unavoidable.

Mr. OSTERMANN instructed Greenblum & Bernstein to make inquiries to ascertain the relevant facts related to preparing this Petition, and to promptly prepare this grantable petition for filing in the U.S. Patent and Trademark Office. The need to investigate and assemble the evidence necessary to file this grantable petition, resulted in any delay from the time of discovery of expiration of the above-identified patent until the time of filing the instant petition. Further,

On July 5, 2011, a decision on the petition was received dismissing Petitioner's Petition and setting a two month due date for requesting reconsideration of the decision. Through further inquiry with Fraunhofer, updated verified statements by Ms. LINDNER and Mr. OSTERMANN were prepared and are attached, which include additional facts and information related to the circumstances surrounding the delay in paying the maintenance fee and to addressing the Petitions Examiner's analysis of Petitioner's Petition in the July 5, 2011 decision.

In particular, Petitioner submits that, as has been set forth above and corroborated by the updated verified statements by Ms. LINDNER and Mr. OSTERMANN, Fraunhofer has been shown to be the party responsible for payment of the first maintenance fee and that, in addition to showing the delay resulted from Ms. LINDNER's error in a clerical function, Petitioner has shown that the error was the cause of the delay, that there was business routine in place for performing the clerical function that could be relied upon to avoid errors in its performance, and that Ms. LINDNER was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon her represented the exercise of due care.

CONCLUSION

Due to the circumstances described, the missed payment of the first maintenance fee was caused by circumstances which were entirely unavoidable. Furthermore, for the reasons given *supra*, the instant request for reconsideration was timely filed.

Accordingly, acceptance of the delayed payment of the maintenance fee due on the above-identified patent is respectfully requested, whereby the patent will not be considered as

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having been expired.

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 19-0089.

Respectfully submitted,
Peter BECHER et al.

/Robert W. Mueller/ Reg. No. 35,043
Robert W. Mueller

Neil F. Greenblum
Reg. No. 28,394

September 6, 2011
GREENBLUM & BERNSTEIN
1941 Roland Clarke Place
Reston, VA 20191
(703) 716-1191
(703) 716-1180 (fax)

Attachments: Statement by Stefanie LINDNER
Statement by Dirk OSTERMANN

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Applicants : Peter BECHER et al.

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U.S. Patent No. 6,764,569

Filed : July 3, 1999

Issued: July 20, 2004

For : ADHESIVE SYSTEM FOR FORM REVERSIBLE GLUED JOINTS

**VERIFIED STATEMENT IN SUPPORT OF PETITION TO ACCEPT DELAYED
PAYMENT OF MAINTENANCE FEE UNDER 37 C.F.R. 1.378(b)**

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop _____
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

I, Dirk OSTERMANN, make the following statements as to my personal involvement with the above-captioned application.

(1) I am an employee in the Patent Department of Fraunhofer-Gesellschaft zur Forderung der angewandten Forschung e.V. [hereinafter "Fraunhofer"], the sole assignee of the above-captioned application.

(2) On February 16, 2011, I conducted a routine check of the Fraunhofer internal docketing system for the status of U.S. Patent No. 6,764,569, and found that the data field for the party responsible for payment of the maintenance fee was PAVIS.

(3) Upon learning that the Fraunhofer internal docketing system identified PAVIS as responsible for payment, I searched the U.S. Patent and Trademark Office's PAIR system and found that U.S. Patent No. 6,764,569 has expired for failure to pay the first maintenance fee

(4) On February 17, 2011, I contacted the law firm of Greenblum & Bernstein, P.L.C. to inquire whether late payment of the maintenance fee would be accepted by the U.S. Patent and Trademark Office. I was informed that, as the patent had been expired for more than 24 months,

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a Petition for Acceptance of Delay Maintenance Fee in Expired Patent would be required under the unavoidable standard of 37 C.F.R. 1.378(b).

(5) Upon request by Greenblum & Bernstein I sought to discover the facts underlying the failure to pay the maintenance fee and provided additional information regarding the original ownership of the patent and identified Stefanie LINDNER of Fraunhofer as the person most knowledgeable about the fact related to the non-payment of the first maintenance fee.

(6) I instructed Greenblum & Bernstein to make inquiries to ascertain the relevant facts related to preparing this Petition, and to promptly prepare this grantable petition for filing in the U.S. Patent and Trademark Office.

(7) After I discovered the expiration of U.S. Patent No. 6,764,569, I acted diligently to ensure the preparation and prompt filing of this grantable petition under 37 C.F.R. 1.378(b).

(8) In my previous verified statement, I incorrectly indicated that Daimler was identified as the party responsible for payment, when in fact the Fraunhofer internal docketing system identified PAVIS as the party responsible for payment.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-captioned application or any patent issuing therefrom.

September 6, 2011
(Date)

D. Ostermann
Mr. Dirk OSTERMANN

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U.S. Patent No. 6,764,569

Filed : July 3, 1999

Issued: July 20, 2004

For : ADHESIVE SYSTEM FOR FORM REVERSIBLE GLUED JOINTS

**VERIFIED STATEMENT IN SUPPORT OF REQUEST FOR RECONSIDERATION OF
PETITION TO ACCEPT DELAYED PAYMENT OF MAINTENANCE FEE UNDER 37
C.F.R. 1.378(b)**

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop _____
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

I, Stefanie LINDNER, make the following statements as to my personal involvement with the above-captioned application.

(1) I am an employee of Fraunhofer-Gesellschaft zur Forderung der angewandten Forschung e.V. [hereinafter "Fraunhofer"], the sole assignee of the above-captioned application, and was in the employ of Fraunhofer in 2005.

(2) I have over 20 years of experience in the administration of patents.

(3) I have worked in the department of patents and trademarks of the patent owner Fraunhofer since 2001.

(4) As part of my employment with Fraunhofer, I regularly attend internal and external training events.

(5) I have been trained to use a patent administration software called PatOrg, which Fraunhofer uses to docket and monitor annuity/maintenance fees. As part of the normal practice

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and procedure, at least twice a year, a routine check is performed by the software to ensure that arrangements have been made for the payment of the annuity/maintenance fees. As part of this check, lists are created to identify annuity matters that have had due dates entered, but for which a party responsible for payment has not been identified. These lists are forwarded to a competent employee for review. Further, a random sampling of the entries in the patent administration software is performed to verify the accuracy of entries.

(6) I was responsible for reviewing attachments to agreements dated May 17, 2005 and June 13, 2005 between Fraunhofer, DaimlerChrysler AG [hereinafter "Daimler"], and Henkel KgaA [hereinafter "Henkel"]. I was informed that, through these agreements, Fraunhofer became sole owner of the invention throughout the world, which included U.S. Patent No. 6,764,569 and several European counterparts.

(7) I was also informed that, upon completion of the June 13, 2011 agreement, Fraunhofer became the party responsible for paying the maintenance fees.

(8) On June 17, 2005, I received the attachments to the agreements that listed the counterpart family member patents, including U.S. Patent No. 6,764,569, that were assigned to Fraunhofer as sole owner. I reviewed the attachment in order to instruct an annuity service to maintain the patents.

(9) Per my review of the attachment, the annuity due dates for maintaining the European counterpart patents were forwarded to the annuity service PAVIS with instructions to pay the fees, but I failed to instruct PAVIS to pay the U.S. maintenance fee.

(10) I entered the U.S. maintenance fee due date into the PatOrg software, but mistakenly entered that PAVIS had been instructed to pay the maintenance fee for U.S. Patent No. 6,764,569.

(11) Because PAVIS was incorrectly entered into the PatOrg software as payor of the U.S. maintenance fee, the routine check performed by the PatOrg software did not identify the instant patent for review for payment.

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(12) I hereby state that my failure to contact the annuity service PAVIS to undertake payment of the U.S. maintenance fees and my error in entering PAVIS as the payor in the Fraunhofer PatOrg software resulted in an unavoidable delay in paying the maintenance fee.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-captioned application or any patent issuing therefrom.

Sept. 6, 2011
(Date)

Stefanie Lindner
Ms. Stefanie LINDNER